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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,140	04/13/2004	Kevin I. Bertness	C382.12-0149	4535
27367	7590	04/05/2006	EXAMINER	
WESTMAN CHAMPLIN & KELLY, P.A. SUITE 1400 - INTERNATIONAL CENTRE 900 SECOND AVENUE SOUTH MINNEAPOLIS, MN 55402-3319			LA, ANH V	
			ART UNIT	PAPER NUMBER
			2612	

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/823,140	Applicant(s) BERTNESS ET AL.	
	Examiner Anh V. La	Art Unit 2612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-24 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1, 3-24 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-8, 10-14, 17, 18, 20, and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Proctor (US 6,614,349) in view of Bohmer (US 5,130,658).

Regarding claim 1, Proctor discloses an apparatus comprising a transmitter 14 transmitting a wireless security signal which defines a perimeter, at least one asset 26 of many types of assets (column 1, line 35- col. 2, line 45) for use in any types of facilities (column 2, lines 1-5), a receiver 40, 44, and a security circuitry 54 coupled to the receiver and configured to disable the asset if the asset is outside the perimeter (col. 2, lines 54-67, col. 3, lines 25-65, col. 4, lines 35-58). Proctor does not disclose the asset being a battery tester. Bohmer teaches the use of a battery tester (col. 1, lines 19-35). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to include the asset being a battery tester to the apparatus of Proctor as taught by Bohmer for the purpose of preventing theft in automotive vehicle service since Proctor teaches that many types of assets can be used (col. 1, line 35- col. 2, line 45).

Regarding claim 17, Proctor discloses an apparatus comprising a transmitter 14 transmitting a wireless security signal which defines a perimeter, at least one asset 26 of many types of assets (col. 1, line 35- col. 2, line 45) for use in any types of facilities

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(column 2, lines 1-5), a receiver 40, 44, and a security circuitry 54 coupled to the receiver and configured to disable the asset if the asset at least partially passes through the perimeter (col. 2, lines 54-67, col. 3, lines 25-65, col. 4, lines 35-58).

Proctor does not disclose the asset being a battery tester. Bohmer teaches the use of a battery tester (col. 1, lines 19-35). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to include the asset being a battery tester to the apparatus of Proctor as taught by Bohmer for the purpose of preventing theft in automotive vehicle service since Proctor teaches that many types of assets can be used (col. 1, line 35- col. 2, line 45).

Regarding claim 23, Proctor discloses a method comprising the steps of transmitting 14 a wireless security signal which defines a perimeter, receiving the transmitted security signal with a receiver 40, 44 embedded in an asset 26 (col. 2, lines 54-60), the asset 26 being one of many types of assets (col. 1, line 35- col. 2, line 45) for use in any types of facilities (column 2, lines 1-5), and disabling the asset if the asset is outside the perimeter (col. 2, lines 54-67, col. 3, lines 25-65, col. 4, lines 35-58). Proctor does not disclose the asset being a battery tester. Bohmer teaches the use of a battery tester (col. 1, lines 19-35). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to include the asset being a battery tester to the apparatus of Proctor as taught by Bohmer for the purpose of preventing theft in automotive vehicle service since Proctor teaches that many types of assets can be used (col. 1, line 35- col. 2, line 45).

Regarding claims 3 and 18, Proctor discloses a radio frequency signal (col. 2, lines 24-43).

Regarding claims 4-5, Proctor discloses all the claimed subject matter as set forth above in the rejection of claim 3, and further discloses the wireless communication being operated in different frequency bands (col. 2, lines 24-43), but does not disclose a Bluetooth protocol (claim 4) and 802.11b protocol (claim 5). However, it would have been obvious to have the radio frequency incorporating a Bluetooth protocol and 802.11b protocol since it is not inventive to discover the optimum or workable ranges by routine experimentation.

Regarding claim 6, Proctor discloses the security signal being defined by a predetermined signal strength (col. 2, lines 54-67, col. 3, lines 25-65, col. 4, lines 35-58).

Regarding claim 7, Proctor as modified by Bohmer discloses the battery tester being outside the perimeter if the security signal being less than the predetermined signal strength (col. 2, lines 54-67, col. 3, lines 25-65, col. 4, lines 35-58).

Regarding claim 8, Proctor as modified by Bohmer discloses the security circuitry disabling the battery tester if a predetermined period of time has elapsed since the tester was outside the perimeter (col. 2, lines 54-67, col. 3, lines 25-65, col. 4, lines 35-58).

Regarding claim 10, Proctor as modified by Bohmer discloses a tool transmitter 40, 44.

Regarding claim 11, Proctor discloses an internal power source 56.

Regarding claim 12, Proctor discloses the receiver comprising an embedded radio frequency identification tag (col. 2, lines 54-67).

Regarding claims 13, 20, Proctor discloses a processing circuitry 20, 22 and an external receiver (figure 1).

Regarding claim 14, Proctor discloses a radio frequency identification reader (fig. 1, col. 2, lines 10-67).

Regarding claim 24, Proctor as modified by Bohmer discloses receiving a theft signal transmitted from the battery tester when the tester is outside the perimeter (figure 1).

3. Claims 9, 16, 19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Proctor in view of Bohmer as applied to claim 1 above, and further in view of Page (US 6,542,080).

Regarding claims 9, 16, 19, and 22, Proctor as modified by Bohmer discloses all the claimed subject matter as set forth above in the rejection of claim 1, but does not disclose the battery tester having an output to output audible noise (claims 9, 19) and an output to output an audible alarm in the processing circuitry (claims 16, 22). Page teaches the use of an output 30 to output audible noise and an output 40 to output audible noise. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to include an output to the battery tester and an output to the processing circuitry of the apparatus of Proctor (as modified by Bohmer) as taught by Page for the purpose of providing audible alarm indication.

4. Claims 15 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Proctor in view of Bohmer as applied to claim 13 above, and further in view of D' Angelo (US 6,265,974).

Regarding claims 15 and 21, Proctor as modified by Bohmer discloses all the claimed subject matter as set forth above in the rejection of claim 13, but does not disclose a memory. D' Angelo teaches the use of a memory (col. 7, lines 54-67). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to include a memory to the processing circuitry of the apparatus of Proctor (as modified by Bohmer) as taught by D' Angelo for the purpose of recording information related to the transmitted theft signal.

Answers to Remarks

5. Applicant's arguments filed on January 17, 2006 have been fully considered.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper.

Applicant has argued that the combination of cited references fail to teach or suggest all of the claimed elements of amended claims 1, 17, and 23. These arguments are not persuasive. The combination of references Proctor (US 6,614,349) and Bohmer (US 5,130,658) teaches all of the claimed elements of amended claims 1, 17, and 23 as set forth above in the rejections of claims 1, 17, and 23.

Applicant has argued that the combination of cited references fail to teach or suggest all of the claimed elements of claims 4-5, 9, 15-16, 19, 21-22. These arguments are not persuasive. The combination of references Proctor (US 6,614,349) and Bohmer (US 5,130,658) teaches all of the claimed elements of claims 4-5 as set forth above in the rejections of claims 4-5. The combination of references Proctor (US 6,614,349), Bohmer (US 5,130,658), and Page (US 6,542,080) teaches all of the claimed elements of claims 9, 16, 19 and 22 as set forth above in the rejections of claims 9, 16, 19 and 22. The combination of references Proctor (US 6,614,349), Bohmer (US 5,130,658), and D' Angelo (US 6,265,974) teaches all of the claimed elements of claims 15 and 21 as set forth above in the rejections of claims 15 and 21.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anh V. La whose telephone number is (571) 272-2970. The examiner can normally be reached on Mon-Fri from 9:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (571) 272-3068. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



ANH V. LA
PRIMARY EXAMINER

Anh V La
Primary Examiner
Art Unit 2612

AI
March 31, 2006